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McKesson Corporation and Alston & Bird LLP
c/o Alston & Bird LLP
Bank of America Plaza
101 South Tryon St., Suite 4000
Charlotte, NC 28280-4000

EXAMINER

COLEMAN, CHARLES P.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHARLES LAMAR CURRAN and RONALD L. CORDELL

Appeal 2015-000764
Application 13/074,892¹
Technology Center 3600

Before MURRIEL E. CRAWFORD, BRUCE T. WIEDER, and
AMEE A. SHAH, *Administrative Patent Judges*.

WIEDER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART and enter a NEW GROUND OF REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b).

¹ According to Appellants, the real party in interest is McKesson Financial Holdings Limited. (Appeal Br. 2.)

CLAIMED SUBJECT MATTER

Appellants' claimed invention relates "generally to a mechanism of generating one or more patient health care summary documents." (Spec. ¶ 1.)

Claims 1, 9, and 17 are the rejected independent claims. Claim 1 is illustrative. It recites:

1. A method comprising:
 - receiving medical information, associated with one or more patients, from one or more different health care entities;
 - identifying one or more unique codes from the received medical information, the unique codes corresponding to one or more code terminologies related to one or more types of medical data;
 - receiving a request from one of the one or more different health care entities for a patient health care summary document corresponding to a patient;
 - analyzing the medical information received from the health care entity to identify one or more code terminologies utilized by the health care entity; and
 - generating, via a processor, the patient health care summary document, in response to receipt of the request from the health care entity, the patient health care summary document is generated based in part on at least one of the code terminologies determined to be utilized by the health care entity.

REJECTIONS

Claims 1–3, 5–11, 13–17, and 19–20 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 1–20 are rejected under 35 U.S.C. § 103(a) as unpatentable in view of Green (US 2011/0264466 A1, pub. Oct. 27, 2011), Sie (US 2011/0146231 A1, pub. Oct. 6, 2011), and Johnson (US 5,664,109, iss. Sept. 2, 1997).

ANALYSIS

The § 101 rejection of claims 1–3, 5–11, 13–17, and 19–20

In the Answer, the Examiner enters a new ground of rejection under § 101 for claims 1–3, 5–11, 13–17, and 19–20. The Examiner determines that “[t]he claim(s) is/are directed to the abstract idea of (i) a method of organizing human activities and/or (ii) a mathematical relationship or formula.” (Answer 3.) The Examiner also determines that “[t]he additional element(s) or combination of elements in the claim(s) other than the abstract idea per se amount(s) to no more than: (i) mere instructions to implement the idea on a computer, and/or (ii) recitation of generic computer structure that serves to perform generic computer functions.”

Appellants argue that the Examiner has not presented a prima facie case of unpatentability under § 101. (Reply Br. 2–4.) Specifically, Appellants argue that “the Examiner’s Answer fails to specifically point out factual evidence that supports a finding that claims 1–3, 5–11, 13–17 and 19–20 are directed to an abstract idea.” (Reply Br. 3.)

We disagree. The USPTO carries its procedural burden of establishing a prima facie case when its rejection satisfies the requirements of 35 U.S.C. § 132 by notifying the applicant of the reasons for rejection, “together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.” *See In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (brackets in original, quoting 35 U.S.C. § 132). Here, the Examiner notifies Appellants that the claims are directed to a patent-ineligible abstract idea, i.e., that the claims are “directed to the abstract idea of (i) a method of organizing human activities and/or (ii)

a mathematical relationship or formula.” (Answer 3.) Thus, Appellants have been notified of the reasons for the rejection with such information “as may be useful in judging of the propriety of continuing the prosecution of [the] application.” *See id.*

Prior to this rejection being made, the Supreme Court decided *Alice Corp. Pty Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347 (2014). *Alice* applies a two-part framework, earlier set out in *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice*, 134 S. Ct. at 2355.

Under the two-part framework, it must first be determined if “the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If the claims are determined to be directed to a patent-ineligible concept, then the second part of the framework is applied to determine “[w]hat else is there in the claims before us?” To answer that question, we consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Id.*

Appellants argue that the claimed invention is not directed to an abstract idea because the claims require identifying “one or more unique codes from the received medical information” and “receiving a request from one of the one or more different health care entities.” (Reply Br. 5.)

We disagree. “The focus of the asserted claims . . . is on collecting information, analyzing it, and displaying [i.e., generating a report that presents] certain results of the collection and analysis.” *Electric Power*

Grp., LLC v. Alstom S.A., 830 F.3d 1350, 1353 (Fed. Cir. 2016).

“Accordingly, we have treated collecting information, including when limited to particular content (which does not change its character as information), as within the realm of abstract ideas.” *Id.* Thus, we are not persuaded that the Examiner erred in determining that the claims are directed to the abstract idea of organizing human activities, i.e., receiving, analyzing, and generating/displaying information.

With regard to the second part of the *Alice* framework, Appellants argue that “the Examiner should consider elements of each claim, both ‘individually’ and ‘as an ordered combination,’ for purposes of determining whether the elements in the claims are directed to ‘something more’ and are thereby transformed into a patent-eligible invention.” (Reply Br. 4.) Moreover, Appellants argue, the claims are directed to “something more” than an abstract idea. (Reply Br. 14–17.) In particular, Appellants argue that the claimed invention relates “to a solution for an improved technique for ensuring that a health care entity that requests a patient health care summary document receives the requested patient health care summary document coded with terminologies understood by the requesting health care entity.” (Reply Br. 15–16.) In other words, Appellants argue that the “something more” is to provide a summary in terms the requesting party will understand. In support of Appellants’ argument, Appellants point to paragraph 3 of the Specification and the problem of different coding systems from different health care entities that “may cause a loss of fidelity in the data that is being exchanged.” (*Id.*; *see also* Spec. ¶ 3.)

We are not persuaded that providing information to a requester in terms the requester will understand constitutes “something more” than the

abstract idea. “[M]erely selecting information, by content or source, for collection, analysis, and display does nothing significant to differentiate a process from ordinary mental processes, whose implicit exclusion from §101 undergirds the information-based category of abstract ideas.” *Electric Power Grp.*, 830 F.3d at 1355. Moreover, the claims “do not include any requirement for performing the claimed functions . . . by use of anything but entirely conventional, generic technology. The claims therefore do not state an arguably inventive concept.” *Id.* at 1356. In short, each step does no more than require a generic computer processor to perform generic computer functions. *See* Spec. ¶ 25 (describing use of generic computers). And considered as an ordered combination, the computer components of Appellants’ method add nothing that is not already present when the steps are considered separately.

Therefore, we are not persuaded that the Examiner erred in rejecting claims 1–3, 5–11, 13–17, and 19–20 are rejected under § 101.

The § 103 rejection

Appellants argue that

Johnson, alone or in **combination** with Green and Sie, is altogether silent and does not teach or suggest that the “health care summary” therein is generated based on any **code terminologies related to one or more types of medical data** that are **determined** to be utilized by any **health care entity that requests a patient health care summary document corresponding to a patient**, as would be required per independent claim 1.

(Appeal Br. 11, footnote omitted.)

The Examiner answers that

Green et al. teach one or more code terminologies utilized by the health care entity, analyzing the medical information received and generating the patient document (Green et al., [0002], [0003]–[0013], [0045]). Sie et al. teach one or more patients and one or more different health care entities (Sie et al., [0002], [0003], [0019], [0111]). Johnson et al. teach a health care [sic] summary document (Johnson et al., Figure 5, Figure 7, col 2, [ll 13-26, col 13, ll 9-11]).

(Answer 5; *see also* Final Action 3–4.)

The Examiner does not indicate where the cited art teaches or suggests determining that the code terminologies used in the summary are utilized by the requesting health care entity. In other words, the Examiner does not indicate where the cited art teaches or suggests that “the patient health care summary document is generated based in part on at least one of the code terminologies determined to be utilized by the health care entity,” as recited in claim 1.

Therefore, we are persuaded that the Examiner erred in rejecting claim 1 and dependent claims 2–8 under § 103. Independent claims 9 and 17 include similar language and for similar reasons we are persuaded that the Examiner erred in rejecting claims 9 and 17 and dependent claims 10–16 and 18–20.

New ground of rejection: § 101 rejection of dependent claims 4, 12, and 18

Pursuant to our authority under 37 C.F.R. § 41.50(b), we enter a NEW GROUND OF REJECTION against dependent claims 4, 12, and 18 under 35 U.S.C § 101.

As discussed above, the focus of the claimed invention is on the abstract idea of receiving, analyzing, and generating/presenting certain results of the collected and analyzed information. Dependent claims 4 and 12 recite “wherein the patient health care summary document comprises a continuity of care document.” The Specification provides no definition for the term “continuity of care document” that would indicate that designating a patient health care summary as comprising a continuity of care document alters the focus of the claim from the abstract idea of receiving, analyzing, and generating/presenting certain results of the collected and analyzed information.

Dependent claim 18 recites that “the patient health care summary document further comprises excluding one or more items of the received medical information designated as private from the generated patient health care summary document.” Presenting certain results of the collected and analyzed information, i.e., excluding some of the collected information while presenting other information, has been treated “as within the realm of abstract ideas.” *See Electric Power Grp.*, 830 F.3d at 1353.

Therefore, we determine that claims 4, 12, and 18 are directed to an abstract idea, i.e., receiving, analyzing, and generating/presenting certain results of the collected and analyzed information.

We now apply the second part of the framework to determine if “the elements of the claim . . . contain[] an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Alice Corp.*, 134 S. Ct. at 2357 (citing *Mayo*, 132 S. Ct. at 1294, 1298).

We determine that merely designating a patient health care summary as comprising a particular type of document, i.e., a continuity of care

document, does not transform the claimed subject matter into patent-eligible subject matter. We also determine that merely excluding some of the collected information while presenting other information, i.e., limiting the content presented, does not transform the claimed subject matter into patent-eligible subject matter. Moreover, taking the claim elements separately, the function performed by the computer processor is purely conventional and adds no inventive concept. Nor do the claims offer detail about the computer system. In short, the claim steps/limitations do no more than require a generic computer to perform generic computer functions.

Considered as an ordered combination, the computer processor of Appellant's claimed invention adds nothing that is not already present when the steps are considered separately. Viewed as a whole, Appellant's claims simply recite the concept of receiving, analyzing, and generating/presenting certain results of the collected and analyzed information. The claims do not, for example, purport to improve the functioning of the computer itself. Nor do they effect an improvement in any other technology or technical field. Instead, the claims at issue amount to nothing significantly more than an instruction to apply the abstract idea of receiving, analyzing, and generating/presenting certain results of the collected and analyzed information. That is not enough to transform an abstract idea into a patent-eligible invention. *See id.* at 2360.

DECISION

The Examiner's rejection of claims 1–3, 5–11, 13–17, and 19–20 under 35 U.S.C. § 101 is affirmed.

The Examiner's rejection of claims 1–20 under 35 U.S.C. § 103(a) is reversed.

We enter a NEW GROUND OF REJECTION of claims 4, 12, and 18 under 35 U.S.C. § 101.

This decision contains a NEW GROUND OF REJECTION pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides that, “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) further provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THIS DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)